Supreme Court, U.S.
FILED
JAN 21 1956
HAROLD B. WILLEY, Clerk

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955

NO. 633

SEARS, ROEBUCK AND CO.,
a corporation,
Petitioner,

vs.

ER-LOCK COMPANY, LTD.,
a corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI

SEARS, ROEBUCK AND COMPANY,
By FRANK E. LIVERANCE, Jr.,
Counsel for Petitioner.
Business Address:
270 East Building,
Grand Rapids, Michigan.

AMERICAN PRINT AND RECORD COMPANY, FIFTY MARKET AVENUE, N.W.,
GRAND RAPIDS 2, MICHIGAN — PHONE GL 6-3232

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955

NO.....

SEARS, ROEBUCK AND CO.,
a corporation,
Petitioner,

vs.

RY-LOCK COMPANY, LTD.,
a corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI

MAY IT PLEASE THE COURT:

The petition of Sears, Roebuck and Co. respectfully shows to this Honorable Court:

REPORTS OF OPINIONS OF LOWER COURTS

The opinion of the United States Court of Appeals for the Ninth Circuit does not yet appear in any official report. It is appended to this petition.

The opinion of the United States District Court, Northern District of California, Northern Division, has not been officially reported. It is at page 16 of the Transcript of Record.

GROUNDS FOR INVOKING COURT'S JURISDICTION

(i) The Court of Appeals for the Ninth Circuit handed down its opinion, which was filed November 21, 1955.

(ii) A petition for rehearing was brought which was denied December 27, 1955.

Motion for stay of the mandate was granted conditioned upon filing a petition for certiorari on or before January 31, 1956.

(iii) The Court has jurisdiction to review the judgment herein under Title 28, U.S.C.A. Sec. 1254 (1) as follows:

> Sec. 1254. Courts of Appeals; certiorari; appeal; certified questions.
>
> Cases in Courts of Appeals may be reviewed by the Supreme Court by the following methods:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree; * * *.

QUESTIONS PRESENTED FOR REVIEW

1. In view of the law governing patentable invention and the exacting standard required, determined by the decisions of the United States Supreme Court, were the findings of the District Court, that the Rust Patent No. 2,380,794, does not represent discovery or invention within the meaning of the patent law, and any changes made represents only the mechanical skill of one conversant with and skilled in the art, having available in the art, teachings of the changes made, clearly erroneous?

2. Where in a crowded art the lower end of a vertically suspended screen is downwardly tensioned by downwardly forced rocking movement on a fixed fulcrum of a tension arm fastened to the screen so that the lower end of the screen has a circular arc path of movement, are the same functions and results attained in the same way, where the lower end of a vertically suspended screen is constrained and held to have solely a vertical movement under tension force applied thereto, and the lower end of such screen does not have a circular arc path of movement?

STATEMENT OF CASE

Suit for patent infringement was brought under the patent statutes, Title 28, Sec. 1338, U.S.C.A. charging infringement of two United States Letters Patents; No. 2,372,912 (R. 191-194) and No. 2,380,794 for Framless Screens (R. 129-132). Complaint is at R. 3 and 4.

Answer (R. 5-8) and Amended Answer (R. 10-14) were filed. Notice by the plaintiff was given (R. 15) that plaintiff would at the commencement of the trial dismiss the Complaint, *with prejudice,* as to Letters Patent, No. 2,372,-912 (R. 191-194). This was done (R. 22-23) and dismissal as to patent No. 2,372,912, *with prejudice,* was ordered (R. 23).

After hearing and submission of the cause, the District Court, by Judge Dal Lemmon (now a Judge of the U. S. Circuit Court of Appeals for the Ninth Circuit) found patent No. 2,380,794 invalid for want of invention (R. 16) and made Findings of Fact and Conclusions of Law (R. 16-18), holding that Plaintiff's patent in suit "does not represent discovery or patentable invention within the meaning of the patent law." (Conclusions of Law, Par. 3, R. 18).

No infringement was found because the patent being invalid, there was no infringement (R. 18). Infringement on the merits was not decided by the District Court.

Judgment (R. 19) was entered holding patent No. 2,380,794 invalid.

The Fact Finding 2 (R. 16), finds no discovery or invention within the meaning of the patent law based on Norquist, No. 1,705,132 (R. 159-167), in essence the first patent sued upon, No. 2,372,912, (dismissed with prejudice), and Boomershine, No. 1,895,309 (R. 168-174), the lever tension arm 6 of which (R. 169), used for screen cloth tensioning, does the same as the lever tension arm of the patent in suit, No. 2,380,794 (R. 130) fulcrumed and actuated the same way for screen tension.

The accused frameless screen structure is shown in Plaintiff's Exhibit 16, essentially the same as Atkinson patent No. 2,553,125 (R. 186-190). The channel C, into which bar B secured at the lower end of the screen cloth is inserted and moves, is anchored in place. The lever F.

is pressed against the upper edge of bar B hooked thereon and not secured thereto. Bar B secured to the lower end of the screen cloth moves vertically in the channel C. The outer end of lever F moves in the arc of a circle, the center of which is the fulcrum at the upper end of vertical leg E. Bar B in fixed and anchored channel C can move solely in a vertical plane.

Patent in suit, No. 2,380,794 (R. 130) has a rail or bar 3 connected at the lower end of screen cloth 1. The flange at lower side of bar 3 projects into a floating bottom strip 4, which is a filling strip sealing any space between the flange 3 and the window sill. Thus far described, there is identity with patent No. 2,372,912 (R. 192) dismissed with prejudice. The first sentence (R. 181) of the description introduces the patent in suit as relating to the type disclosed in patent No. 2,372,912.

In the dismissed patent No. 2,372,912, a tensioning member is fixedly secured to the flange 6*a* of the lower end screen connected bar. It is a horizontal, inwardly extending loop 12. A double threaded screen 14 driven at its lower end into the window sill, extends vertically through loop 12. A clamping nut 17, screwed down on the upper threaded end 16 of screw 14, causes a downward vertical pull which tensions the screen cloth 1, which is anchored at its upper end, with the screen 1 at its vertical edges against the outer sides of the window frame vertical sides, such outer sides known as the window "blind stop".

Patent in suit, No. 2,380,794 (R. 130) has the same anchoring of the upper end of the screen cloth, an identical lower bar 3, the lower edge portions extending into the floating channel 4. In both, channel 4 in No. 2,380,794 and channel 11 in No. 2,372,912 are free to go with the lower screen bars, as when a screen is detached at its lower end from the window sill and swung outward, as at R. 134.

In No. 2,380,794 in suit (R. 130), a rigidly fixed arm 9 is connected to the lower screen bar, at the same place as, and extends inwardly like loop 12 of No. 2,372,912 (R. 192). It is forced downwardly by thumb nut 13 on the threaded upper end 14 of the bolt shank 12, (R. 130). The lower end of bolt 12 is fixed to the sill, as double threaded screw 14 in No. 2,372,912 is fixed to the sill.

The structural difference is that loop 12 of No. 2,372,912 at its inner end is free, while the inner end of arm 9 of

No. 2,380,794 bears upon the upper end of a fulcrum 8, fixed with relation to the sill.

In No. 2,380,794, in suit (R. 130), the upper edge of the inner leg of channel 4 makes a stop to the downward movement of bar or flange 3 which when moved downward in the channel 4 far enough will bring the outer end of arm 9 against such leg. It is also true in the same way in No. 2,372,912. As disclosed, in No. 2,380,794 in suit, the lower end of the screen cloth can not reach the horizontal plane of the upper end of fulcrum 8 because of such positive stop.

Norquist et al. No. 1,705,132 (R. 159-167) is essentially the dismissed patent No. 2,372,912 (R. 192). Figs. 3 and 4 of Norquist et al. (R. 161) disclose screen 20 anchored to the window at its upper end, an inverted channel bar at its lower end, a floating sealing strip 60 extending into the channel and resting on the sill, the channel and strip 60 being merely reversed or interchanged in position in Rust No. 2,372,912 (R. 192) with identical results. A tension arm in Norquist et al (the upper ear 67) is fixed to the screen lower end bar, extending horizontally inward. A bolt (anchoring pin 71), has its lower end head conected to a sill attached bracket, passes upwardly through the tension arm 67, is threaded at its upper end and has a force exerting nut 73 on it, turning downward of which tensions the screen vertically.

The voluntary dismissal *with prejudice,* by plaintiff, of patent No. 2,372,912, was caused, in part at least, it is believed, because anticipated by Norquist et al. The District Judge relied on Norquist et al, in fact finding, paragraph 2 (R. 16) as having essentially all in the dismissed patent, and further, in mechanical detail, the same tensioning bolt, sill bracket mounted, as the sill bracket carried bolt 12 of No. 2,380,794, in suit (R. 130).

ARGUMENT AND DISCUSSION

1. In view of the law, governing patentable invention and the exacting standards required, determined by the decisions of the United States Supreme Court, were the findings of the District Court, that the Rust Patent No. 2,380,794, does not represent discovery or invention within the meaning of the patent law, and any changes made represents only the mechanical skill of one conversant with and skilled in the art, having available in the art, teachings of the changes made, clearly erroneous?

The Supreme Court has frequently referred to the "*exacting standards* of our patent system". *General Electric Co. vs. Jewel Incandescent Lamp Co.,* 326 U. S. 242; 66 S. Ct. 81, @ page 84.

Great Atlantic & Pacific Tea Co. vs. Supermarket Equipment Corp., 340 U. S. 147; 71 S. Ct. 127, at the end of the majority opinion, p. 131, referred to "a standard of invention" being by the lower Courts "used that was less exacting" than required; and in such case the certiorari petition was granted though both of the lower courts concurred in upholding validity, and no conflicting opinion. The concurring opinion was more emphatic on standards required.

The petitioner herein is not faced with concurring decisions upholding validity in the lower courts. The trial court, properly following the Supreme Court, it is believed, found the patent in suit, No. 2,380,794, invalid as not representing discovery or invention within the meaning of the patent law, with cogent reasons in the Findings of Facts (R. 16-17) in support.

There have been recent Supreme Court cases involving patents, brought up on certiorari petitions, where the trial court found invalidity, and the Appellate Court reversed, and no conflicting decision from another Appellate Court. As *Sinclair & Carroll Co. vs. Inter-Chemical Corporation,* 325 U. S. 327; 65 S. Ct. 1157. Also *Graver Tank & Mfg. Co. vs. Linde Air Products Co.,* 336 U. S. 271, 69 S. Ct. 535, @ p. 539.

Such case of *Graver Tank & Mfg. Co. vs. Linde Air Products Co., supra,* further very clearly indicated that not merely lip service should be accorded Rule 52 (a)

of the Federal Rules of Civil Procedure, 28 U. S. C. A. but deference to the findings of the trial court was due, the same when claims of a patent are overturned as well as when sustained (last sentence, p. 539 of 69 S. Ct.). There was a reversal of the Seventh Circuit Court of Appeals, though there was not established to a certainty that the lower court's findings were right. They, however, were not convincingly shown to be clearly erroneous, and could not be set aside in absence of such showing.

• • •

The District Court (R. 16) ruled:

> "The Court will find patent No. 2,380,794 is invalid for want of invention."

The court heard the witness, Rust, give his testimony. At R. 47 et seq. installation is described. The top bracket 8 in No. 2,372,912 (R. 192) or bracket 2 in 2,380,794 (R. 130) is adjusted and secured so that the screen is against the window blind stop. The sill connected bracket (R. 130) is fixed so the lower end of the screen will come against the blind stop when arm 9 is hooked over the fulcrum 8. Thereafter the vertical tensioning of the screen is described (R. 48) by turning down thumb nut 13.

At R. 49 the tensioning of the screen is testified as important as "without proper tension of the screening you would get a flapping condition; I mean, it would not be tight, and, consequently, the effectiveness would be destroyed, the bugs would come in from the side."

Like all frameless screens, from the first in 1895, to Ramsden, 551,095 (R. 137), the vertical tensioning is the thing important. Proper installation against the window blind stop followed by vertical tensioning so that the screen is "tight" and not slack and loose, insures bugs are excluded.

The opinion of the Ninth C.C.A. on its second page, sets out the supposed sealing movement of the lower end of the screen when tensioned by forcing the tension arm down. It says there is simultaneously a tensioning of the screen and a movement of the screen toward and against the blind stop, because of the rocking movement of the tension arm.

There is no testimony regarding this. Patent No. 2,380,794 (R. 130) in suit makes no such statement.

However, to all skilled in an art, a patent in such art speaks a universal language. Obviously the lower end of screen 1 in patent No. 2,380,794 moves in the arc of a circle, the radius of which is from the upper end of fulcrum 8 to the lower end of the screen where it bends upwardly into the inverted-U upper end portion of the screen attached lower bar.

Also obviously, following such arc path of movement, there can be no movement of the screen toward the blind stop until after the lower end of the screen comes into horizontal alignment with the upper end of fulcrum 8 and moves downward past such horizontal position.

This will be clear on considering a circle having a horizontal diameter line across it. Moving downward in the path of such circle from a point above one end of the diameter caries outward until the end of the diameter is reached. Thereafter continuing the downward movement will reverse to inward movement.

As the lower end of screen 1 is *always above* a horizontal line through the fulcrum what the opinion of the Ninth C.C.A. states is opposite to what occurs. It is positively wrong. The lower end screen movement is *away* from and *not toward* the blind stop on tensioning the screen.

A patent drawing can speak a universal language. But it must be read correctly. The obviously incorrect reading by the Ninth C.C.A. has no support. The patent description says nothing about it. The testimony has no word concerning it.

The purported advantage instead is a disadvantage. It is of little consequence because the outward movement away from the blind stop is negligible. The thought to be inward movement wrongly found by the Ninth C.C.A. would, if it was so, likewise would be negligible.

The only useful accomplishment performed by downward rocking movement of tension arm 9 of patent No. 2,380,794 (R. 130) is vertical tensioning of the screen.

Vertical screen tensioning in frameless screens is obviously easily done by skilled mechanics in many ways; directly as in Norquist, No. 1,705,132 (R. 159 et seq.) or Marshall, 1,672,896 (see Figs. 4, 7 or 7*a*, R. 154-155) and,

of course, the first one, Ramsden 551,095 (R. 137). Tensioning in the same direction, using a simple lever, done by Boomershine, 1,895,309 (at R. 169) was not only to be expected from those skilled in the art, but was before them available for use.

The fact finding numbered 2 (R. 16-17), is manifestly correct, and the absence of deference of the Ninth C.C.A. to such finding is clear.

Invention calls forth a higher effort than that done by an "ordinary person skilled in the art to which the subject matter pertains". However, this effort is characterized, "genius", intuitive, creative or inventive (footnote p. 131 of 71 S. Ct. 127), it must appear to have a patent valid.

Sinclair & Carroll Co. vs. Interchemical Corporation, supra, at p. 1145 of 65 S. Ct. states it is "an essential requirement for validity of a patent that the subject matter display 'invention', 'more ingenuity • • • than the work of a mechanic skilled in the art'."

There must be a substantial contribution to the fund of public knowledge. *Dow Chemical Co. vs. Halliburton Oil Well Cem. Co.,* 324 U. S. 320, 65 S. Ct. 647, @ paragraph (4), p. 650.

The District Court found the patent in suit invalid "for want of invention". The primitive savage who having lifted a log by direct lift thereon, using the limb of a tree as a lever across a fulcrum, anticipates the change from direct downward force application to a screen (as in Norquist, 1,705,132, R. 159 et seq.; or Rust, 2,372,912, R. 192) to using a simple fulcrumed lever to apply such force as in the patent in suit, irrespective of Boomershine (R. 169).

The patent in suit, No. 2,380,794, is, like those mentioned at p. 132 of 71 S. Ct., *Great Atlantic & Pacific Tea Co. vs. Supermarket Equipment Corp.,* one of the many incredible, spurious and flimsy patents which have been spawned by the Patent Office. The statements of Mr. Justice Bradley in *Atlantic Works vs. Brady,* 107 U. S. 192; 2 S. Ct. 225, are directly applicable. "Monopoly is not to be granted for every trifling device, • • • which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers."

The patent in suit should not have issued. The District Court following settled law, invalidated the patent for want of invention, most manifestly correct, supporting such ruling by correct findings of fact and conclusions of law. That should have terminated the matter.

The Appellate Court, violating settled law and, in effect, flouting the ruling, findings and conclusions of the District Court, instead of giving due deference thereto, has turned the situation into a deplorable one, correction of which is believed imperatively needed.

2. Where in a crowded art the lower end of a vertically suspended screen is downwardly tensioned by downwardly forced rocking movement on a fixed fulcrum of a tension arm fastened to the screen so that the lower end of the screen has a circular arc path of movement, are the same functions and results attained in the same way, where the lower end of a vertically suspended screen is constrained and held to have solely a vertical movement under tension force applied thereto, and the lower end of such screen does not have a circular arc path of movement?

In the patent in suit (R. 130) the purported invention resides functionally in the lower end of the screen following a circular path of movement when downwardly tensioned which causes the screen at its lower end not only to be pulled down vertically but simultaneously move horizontally. The Appellate court says it will move horizontally toward the blind stop. It would do so if the lower end of the screen was below the horizontal plane of the fulcrum 8. But with the lower end of the screen above such plane the horizontal movement is *away* from the blind stop.

The circular path of movement of the lower end of the screen is compelled because the bar at the screen lower end is permanently secured by a rigid riveted connection to the rocking tension arm 9.

In the accused structure (Plaintiff's Exhibit 16), like Atkinson, No. 2,553,125 (R. 187) the bar attached at the lower end of the screen moves in a channel (C in Exhibit 16 and 24-25 in the Atkinson patent Fig. 3) which is fixed and anchored to the sill. Such bar at the lower end of the screen can have only a vertical movement in the chan-

nel and has no horizontal bodily movement. It has no movement either toward or away from the blind stop. Such anchoring is admitted by the plaintiff (R. 90) and is evident.

The tension arm (F in Exhibit 16 and 14 in the Atkinson patent R. 187) hooks over the upper edge of the screen attached bar, has no securing and fixing comparative or equivalent to the rigid connection of the arm 9 to the lower end screen bar of the patent in suit (R. 130).

The art is crowded. The Book of Exhibits (R. 129 to 194) shows it.

The application of equivalents is a question of law. In a crowded field, crowded almost if not completely to the point of exhaustion, as in *Halliburton Oil-Well Cementing Co. vs. Walker*, 329 U. S. 1, 67 S. Ct. 6, @ p. 11, equivalents are granted in a very narrow range if the patent is valid at all, and are not given so that the patent in effect covers the functions which it attains.

Other structures attaining generally the same functions and results in many ways in the crowded field where the patent is located, as the numerous patents in the record show, preclude a construction and interpretation of the patent and its claims in the present suit as erroneously construed and interpreted by the Ninth C.C.A.

• • •

The patent in suit gets a tensioning of the frameless screen by merely another and, that, an old way of applying screen tension differing from the first Rust patent (R. 192) and Norquist et al. (R. 161) in using a lever application of force (old in Boomershine, R. 169) in place of a horizontal tension arm without fulcrum (12 in Rust, R. 192, and 67 in Norquist et al., R. 161).

The ruling of the District Court that the patent was invalid because of lack of invention properly follows settled law. It is a violation of the law and the matter becomes a question of law upon the Appellate Court reversing the District Court.

The infringement question becomes a question of law as the application of equivalents is based upon the law which governs equivalents, broad and generous for pioneer inventions, limited, narrow and restricted to what is substantially shown in the patent disclosure with nar-

row patents in a crowded field, crowded almost to the point of exhaustion.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Court of Appeals for the Ninth Circuit, commanding that court to certify and send to this court for its review and determination on a day certain to be therein named a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket, No. 14,144, Ry-Lock Company, Ltd., a corporation, appellant vs. Sears, Roebuck and Co., a corporation, appellee, and that the said judgment of the United States Court of Appeals for the Ninth Circuit may be reversed by this Honorable Court and that your petitioner may have such other and further relief in the premises as this Honorable Court may seem meet and just.

Respectfully submitted,

SEARS, ROEBUCK AND COMPANY,
By FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

APPENDIX

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

RY-LOCK COMPANY, LTD., a Corporation,
Appellant,

vs.

No. 14,144
Nov. 21, 1955

SEARS, ROEBUCK & Co., a Corporation,
Appellee.

Appeal from the United States District Court for the Northern District of California, Northern Division

---

Before BONE and POPE, Circuit Judges, and MURRAY, District Judge.

POPE, Circuit Judge:

The appellant here, called Ry-Lock, as assignee of the inventor and patentee, brought this suit for infringement of letters patent No. 2,380,794, which was issued for a "tensioning and locking device for frameless window screens." The defendant, Sears, Roebuck & Co., here called Sears, was charged with selling tensioning and locking devices for frameless window screens which infringed Ry-Lock's patent. The sales occurred at Sears' store at Sacramento, California.

Upon the trial below the court found that Ry-Lock's patent was void for want of the required novelty, utility and advance in the art; that the patented device was anticipated by earlier patents, and entered judgment for the defendant Sears.

The subject matter of the patent concerns a combination made up of a "sill-bracket" and a "tension arm". The drawings and specifications show that the sill-bracket is

a metal part which is secured by screws to the sill of the window upon which a frameless window screen is to be installed. It is so designed as to provide an opening for the insertion of a bolt with wing-nut extending upward from the sill-bracket. A special feature of the sill-bracket is that at the end toward the inside of the window, there is an upturned flange forming a fulcrum. The tension arm is rigidly fixed by rivets or other means to a metal bar or flange across the bottom of the screen and just above the portion of the flange which is designed to make tight contact with the window sill. This tension arm extends in the direction of the inside of the window and is so located that it will fit over the upturned flange or fulcrum portion of the sill bracket previously described. It is provided with a longitudinal slot through its center so as to accommodate the bolt in the sill bracket. The outer ends of the tension arm (one on either side of the slot) are turned down so as to hook or project over the upturned flange or fulcrum on the sill bracket. When the tension arm is in this position on the sill bracket, the wing-nut on the bolt may be tightened and thus tension placed upon the top of the tension arm which in turn puts tension on the screen and brings the flange at the base of the screen structure into contact with the window sill at the base. Because the innermost portion of the tension arm is hooked over the fixed fulcrum, the turning of the wing-nut and tightening of the bolt gives the tension arm a rocking movement the effect of which is not merely to tighten the screen but to move the screen snugly against the blindstop along the vertical sides of the window. Thus the bottom of the screen moves flush against the sill and the sides of the frameless screen are brought to fit closely against the blind stop and eliminate any openings for the admission of insects. The rocking motion described is readily possible because the slot in the tension arm is a longitudinal one.

About the time the patent was granted in 1945, Ry-Lock began manufacturing and selling its device, which met with great commercial success. In the years from 1946-50, Sears purchased and sold it. It advertised the device as being of a "revolutionary new style" and as having numerous points of superiority over other devices for installing window screens. The specifications for construction contracts proposed to be let by the United States Government

used a reference to these Ry-Lock devices as basis for the product called for in the specifications requiring that "Tension type screens shall be a standard product of an established manufacturer, similar or equal to the approved Ry-Lock tension screens as manufactured by the Ry-Lock Company, Ltd., San Leandro, California."

At the time the patent was issued and Ry-Lock's manufacture of these screens began, there was nothing on the market which in any manner resembled the Ry-Lock device. A Columbia frameless window screen was manufactured, but the mode of tension there provided for was through the use of a lever attached to the side of the flange to which the bottom of the screen was attached. The lever hooked over the heads of screws in the window sill and the screen was tensioned by a simple push of the lever. It bore no resemblance to Ry-Lock's patented device.

Considered by itself in the light of what had been previously manufactured and used or what had been commercially available, it would appear that the Ry-Lock device was both new and useful and measured up to the ordinary standards of invention. The trial court's finding of invalidity appears to have been based upon its belief that the claimed invention had been substantially anticipated in prior art patents to which the court alluded in its findings. The primary question here is therefore with respect to Sears' claim of anticipation.

In this connection it should be noted that after Ry-Lock had put in its proof consisting of numerous exhibits disclosing its patent, operating models thereof and fabricated parts, together with oral evidence explaining the history of the invention, the manner and mode of using the device and its commercial success, and had introduced evidence of the claimed infringement, Sears in presenting its defense limited its proof to the printed copies of the earlier United States letters patent and relied upon these prior patents to establish the claim of anticipation, without any attempt to support that claim by testimony of experts or other witnesses. No physical representations or samples of the devices described in these prior patents were produced and it does not appear that any of the claimed anticipating devices were ever manufactured or sold. We note therefore that the findings of the trial court

with respect to anticipation were based solely upon these paper patents unsupported by any testimony of witnesses in open court. It follows that we are in as good a position as was the trial court to consider and evaluate the anticipatory effect of the patents brought forward by Sears.

The two patents in which the district court found anticipation were Norquist No. 1,705,132 and Boomershine No. 1,895,309. The Norquist patent was for a window screen, part of which disclosed a means of tensioning or tightening the frameless screen. The drawings and specifications of Norquist show brackets affixed to the inner side of a cross bar at the lower end of the screen; extending vertically through these brackets is a pin, the lower end of which is flared and enlarged so that it may be slipped into a slot provided in the outer side of a three cornered latch screwed to the window sill. The upper end of the pin is threaded so that it may accommodate a collar which can be turned by hand on the threads. Between the collar and the top of the bracket a spring is slipped over the pin so that when the collar is turned upon the threads the spring is tightened and presses down upon the brackets thus giving tension to the screen.

Except for the fact that turning the collar upon the threads will furnish tension and tighten the screen, this Norquist device appears to have little resemblance to Ry-Lock's combination for Ry-Lock utilizes the principle of a lever operating upon a fulcrum, and the tightening of the bolt with a wingnut furnishes the rocking action which not only creates downward tension but makes the screen taut against the blindstop. Ry-Lock's device thus utilizes an anchor type fulcrum upon which operates a tension lever arm with the turned-over "detents" which hold the lever arm in proper relation to the fulcrum, and furnishes means for pressure which supplies both vertical tightness and longitudinal tautness.

Boomershine, the other patent upon which the trial court's finding of anticipation is based, appears to have even less resemblance to any principle applied by Ry-Lock. It is true that it deals with flexible material which might include a screen. It is entitled "Stretching and securing means for flexible material". It shows a means of fastening a screen or other flexible material on a window frame. As that material is brought over the square edge of the frame it is made taut and stretched by the use of

a lever-like device through which a screw is inserted. The lever is shaped like a dogleg and its lower end is pressed against the outer portion of the extended screen; then as the screw is tightened it brings the other end of the lever down upon the screen furnishing additional tension drawing the screen tighter over the frame.

It is true that Ry-Lock utilized the principle of a lever in the manner we have previously described. It is also true that the principle of the lever is probably as old as the oldest mechanical art, but it must be borne in mind that Ry-Lock's patent was for a combination. There is no doubt but that the various parts utilized by Ry-Lock were, separately considered, old, but we think that the mere fact that Norquist utilized a collar operating on threads in a pin, and that Boomershine utilized the lever in an entirely different type of operation, is not sufficient to establish the defense of anticipation sought to be set up by Sears. Each of the elements making up Ry-Lock's combination performs a substantial and necessary function in bringing about new results. *Winslow Engineering Co. vs. Smith,* 9 cir. 223 F. 2d 438.[1] In our view there is invention here, for the whole of what Ry-Lock has produced exceeds the sum of its parts, and it measures up to the standards of invention which this court has approved in the Winslow case, supra. Indeed, we are of the opinion that the finding of want of invention and of anticipation which the trial court made was inherently defective and insufficient. It is set forth at length in the margin.[2]

---

[1]Rehearing has been granted in that case limited to points other than the one for which it is here cited.

[2]"2. Patent No. 2,380,794 is a patent for a tensioning and locking device for frameless window screens and is in a crowded field of that art. Such patent combines elements old in the art of frameless screens, in substantially the same way as the patent to Norquist et al., No. 1,705,132, differing therefrom only in the substitution of a simple lever secured at one end to the lower edge strip of the screen cloth and fulcrumed at its end farthest away from its point of attachment, instead of being free at such end as in Norquist et al., but getting a tensioning of the screen in the same direction by a sill anchored bolt extending upwardly having a tensioning nut thereon above such arm or lever like Norquist et al. Such fulcrumed lever, tensioned in the same manner and for the purpose of tensioning a screen, is not new, being shown in the earlier patent to Boomershine, No. 1,895,309. The Rust patent No. 2,380,794 does not represent discovery or invention within the meaning of the patent law, and any changes made over the Norquist patent represents only the mechanical skill of one conversant with and skilled in the art, having available in the art, teachings of the changes made. The structure described and claimed in patent No. 2,380,794, lacks such patentable novelty, utility and advance in the art of tensioning and locking devices for frameless window screens as is necessary to establish invention."

This invention, made up by combination of elements, in a manner which was sufficiently new and novel to measure up to the accepted standards of invention, was not, in the language of *Himes vs. Chadwick,* 9 cir. 199 F. 2d 100, "a mere aggregation of a number of old parts". Hence, a finding which, as here, picks out one element in one prior patent and another element in another prior patent as a demonstration of anticipation, is manifestly insufficient to overcome the presumption arising from the issuance of the patent, a presumption reemphasized by the existing Act. 35 U.S.C.A. §282.[3]

We hold therefore that the findings of lack of invention and of anticipation are clearly erroneous. Sears wholly failed to present a case to justify the findings made. The record compels a finding that the patent was valid.

The question of infringement remains. The evidence in our judgment so clearly demonstrates infringement that a finding of no infringement on this record would have been clearly erroneous.

A consideration of the models and drawings of the accused device shows that all of the features above described which are basic to the combination of elements which the inventor of Ry-Lock's patent has assembled are utilized in the accused device. In that device we find the anchor type fulcrum, substantially the same tension lever arm, the same means for pressure, and the same action designed to make the screen taut against the blind stop, all assembled in a combination which in substance is not to be distinguished from that which belongs to Ry-Lock. There are certain immaterial variances in these elements in the accused device, which as made up appears to be merely an inferior imitation of Ry-Lock's patent. The sill bracket screwed to the window sill, like that of Ry-Lock, has an upturned flange forming a fulcrum. Instead of being a wide flange over which the tension arm detents are fastened, it has the equivalent in the form of a narrow upturned flange over which a circular opening in the lever tension arm fits. The variances in the assembly are spurious departures. The lever tension arm has a shorter longitudinal slot sufficient to permit the bolt to accommodate

---

3"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

the rocking action called for by the Ry-Lock patent; the lever tension arm is not fastened rigidly to the lower crossbar of the screen but is merely hooked over that crossbar. Like the lever tension arm of Ry-Lock it is channel shaped and the ends of the side flanges forming the channel are notched at the end nearest the screen to permit them to be hooked over the crossbar. This lever tension arm in the accused device is more flimsy and would appear to be more difficult to assemble than that of Ry-Lock, but it produces "substantially the same result in substantially the same way" and infringement results. *Royal Typewriter Co. vs. Remington Rand,* 2 cir. 168 F. 2d 691, 692.

In view of the clear proof of infringement, we hold that the judgment must be reversed and the cause remanded to the district court with directions to enter judgment in favor of the plaintiff Ry-Lock and against the defendant Sears with an injunction against a further infringement by the defendant. The court is further directed to proceed to an accounting of plaintiff's damages and to an assessment of costs against the defendant.

(Endorsed:) Opinion. Filed Nov. 21, 1955.

Paul P. O'Brien,
Clerk.

JUDGMENT

Appeal from the United States District Court for the Northern District of California, Northern Division.

This cause came on to be heard on the Transcript of the Record from the United States District Court for the Northern District of California, Northern Division, and was duly submitted.

On consideration whereof, it is now here ordered and adjudged by this Court, that the judgment of the said District Court in this cause be, and hereby is reversed, with costs in favor of the Appellant, and against the Appellee, and that this cause be, and hereby is remanded to the said District Court with directions to enter judgment in favor of the plaintiff Ry-Lock and against the defendant Sears with an injunction against a further infringement by the defendant, and that the said District Court is fur-

ther directed to proceed to an accounting of plaintiff's damages and to an assessment of costs against the defendant.

IT IS FURTHER ORDERED and adjudged by this Court, that the Appellant recover against the Appellee for its costs herein expended and have execution therefor.

(ENDORSED) Judgment
Filed and Entered: November 21, 1955.

Paul P. O'Brien,
Clerk.

ORDER DENYING PETITION FOR REHEARING

Excerpt from Proceedings of Tuesday, December 27, 1955.

Before: BONE and POPE, Circuit Judges, and MURRAY, District Judge.

On consideration thereof, and by direction of the Court, IT IS ORDERED that the petition of Appellee filed December 14, 1955, and within time allowed therefor by rule of Court for a rehearing of the above cause be, and hereby is denied.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955

No. 633

SEARS, ROEBUCK AND CO.,
a corporation,
Petitioner,

vs.

RY-LOCK COMPANY, LTD.,
a corporation,
Respondent.

PETITION FOR REHEARING

Comes now the above named petitioner, Sears, Roebuck And Co., and presents this, its petition for rehearing of the above entitled cause, wherein a petition for Writ of Certiorari was denied, March 12, 1956, and, in support thereof, respectfully shows:

1. That the petitioner, in its amended answer to the complaint (Sec. IX, R. pp. 12, 13, 14), alleged that the patentee, David Jordan Rust, was not the first and original inventor of the structure disclosed in patent No. 2,372,912 (Exhibit Book, R. 192-194); that the invention of said patent was known to said Rust to have been in public use and on sale for more than one year prior to his application of Letters Patent No. 2,372,912; and that there was perpetrated, in applying for said Letters Patent, a fraud upon the public and the United States Patent Office, such application at its time of filing being filed knowing that the alleged inventions disclosed and claimed by said Letters Patent, No. 2,372,912 were not new and patentable, and had been in use and on sale for more than one year prior to the application therefor; and that such

Letters Patent No. 2,372,912 were obtained surreptitiously and fraudulently, knowing that the inventions of said Letters Patent No. 2,372,912 were not the inventions of said Rust.

2. The patentee, Rust, admitted selling frameless screens prior to 1942 (bottom of page R. 94) admitted selling the same under the trade name "NU WAY" in 1938-1940 (R. 95); admitted (R. 98 extending to R. 99) that he knew there had been installed in Oakland in the year 1939 several frameless screens having the approximate structure of Defendant's Exh. A (Exhibit Book 135); admitted the settlement of a suit for declaratory judgment brought by the Lang Company asking for a ruling of invalidity of Patent No. 2,372,912 (R. 98); admitted that the structure of the "NU WAY" screen was substantially Defendant's Exhibit A, (Exhibit Book 135) and, (R. 102), brought in Plaintiff's Exh. 18 as the structure of the "NU WAY" frameless screen made and sold by him and the respondent years prior to the filing date of Letters Patent No. 2,372,912 which exhibit is substantially the same as Defendant's Exhibit A (R. 135), and is an anticipation of the claimed structure of patent 2,372,912.

3. Such "NU WAY" structure (Exhibit Book 135) conforms exactly, word for word, in every respect and detail to claims 1 and 2 of the Rust patent, No. 2,372,912.

4. Rust, the inventor, knew of this "NU WAY" structure; knew of the floating channel and the flange extending into it; knew of a manually operable tension means connected to the bar at the lower end of the screen which was engaged with a keeper on the sill to tension the screen vertically; and knew it had been manufactured and in public use in 1939 at the time he filed application for patent No. 2,372,912, on July 25, 1944 (Ex. Book, 192).

5. The application for patent was filed with claims 1 and 2 of patent No. 2,372,912 (such claims at Ex. Bk. 194). Such claims 1 and 2 are a word picture of the "NU WAY" screen (Exhibit Book 135) admittedly on the market and in public use in 1939, and sold by the patentee, Rust.

6. The plaintiff (respondent herein), in this suit and in the prior litigation instituted by the Lang Company (R. 98) avoided and side-stepped determination of the validity issue respecting such patent No. 2,372,912, and has

held and still holds this patent as a threat to the public, such patent being fraudulently and surreptitiously obtained.

7. After suing the petitioner herein on such patent, and putting petitioner to the trouble and expense of hunting out and establishing the facts of invalidity because of prior public use and sale, an avoidance of a ruling on invalidity was done by voluntarily dismissing the suit on such patent with prejudice, the patent still remaining a threat to the public.

8. Such patent No. 2,372,912, obviously void and known to be so, applied for in 1944 after direct knowledge of prior public use and sale in 1939 by the patentee himself, five years earlier than applying for patent, and with such applicant (Rust) not the one who devised the "NU WAY" structure (Ex. Book 135) thus sold, the respondent is smothered in inequity, and is before the court with unclean hands.

DISCUSSION AND ARGUMENT

A *valid* patent is not, accurately speaking, a monopoly. (*United States vs. Dubilier Condenser Corp.*, 289 U. S. 178; 53 S. Ct. 554 @ p. 557, (1)). An *invalid* patent, however, is an indefensible monopoly. It conforms to the definition of a monoply stated by the Supreme Court in such citation. For an existing patent which is prima facie valid but actually invalid deprives the public of that which it should freely enjoy.

When, as here, the respondent as owner of Patent No. 2,372,912 (Ex. Bk. 192) must know of the invalidity of such patent, yet persists in holding its threat over the public and avoids and averts any and all judicial determination of the question, it is submitted, it is not in the court with clean hands.

Having fraudulently obtained the patent, knowing of the prior use and sale which must invalidate such patent, yet maintaining the threat for future holding over the public so that each and everyone accused of infringement must endeavor, as well as may be, to obtain the evidence of invaladity, it is submitted, that the entire proceeding brought by Ry-Lock Company, the respondent, against Sears, Roe-

buck And Co., the petitioner, is so tainted with fraud, deceit and inequity that such respondent, not before the court with clean hands, should be refused any standing in and assistance by a court.

• • •

In *Precision Instrument Mfg. Co. vs. Automotive Maintenance Machinery Co.,* 324 U. S. 806; 65 S. Ct. 993, one of the three patents in such suit was so smothered in inequity that the plaintiff, owner of such patent, was denied all relief as to such patent and the other two patents, being held not to have clean hands. It was held to be a requirement that the one coming into equity shall have acted fairly and without fraud or deceit (at p. 997, 65 S. Ct.).

At page 998, it was held that where in a suit in equity, public interest as well as private interests of the litigants are concerned, the doctrine assumes even wider and more significant proportions.

A patent is a restriction upon the public. It does not concern only an alleged infringer, but it is a matter in which the public is vitally concerned. A patent owner *properly* excludes the public from manufacture, use or sale of his patented structure if his patent is *valid.* But when his patent is *invalid,* and the patentee must have known, and his acts as in this case show did know of its invalidity, it is submitted that there is that inequity present to justify the petitioner herein to ask for an exercise of the wide range to an equity court's use of discretion in refusing aid to an unclean litigant, like done in *Precision Instrument Mfg. Co. vs. Automotive Maintenance Machinery Co.,* supra.

Such case and the numerous citations therein, define the wide range of an equity court's use of its discretion in refusing aid to unclean litigants and one particularly where the public interest is vitally concerned as it is in conjunction with Letters Patent of the United States for inventions.

Always where acts are contrary to the public interest in conjunction with patents for invention, courts of equity may appropriately withhold their aid in a case where the plaintiff owner of a patent is using the right asserted contrary to public interest. *Morton Salt Co. vs. G. S. Suppiger Co.,* 314 U. S. 488; 315 U. S. 788; 62 S. Ct. 402.

These cases unerringly point the direction which is followed. The record of this case shows not only invalidity of the patent No. 2,372,912, but that the patentee knew of the prior structure which invalidates such patent, handled it and sold it five years before he made application which resulted in patent No. 2,372,912; and after issuance of patent No. 2,372,912 asserted it strongly.

A license has been granted which includes such patent No. 2,372,912 as well as others (R. 57-93). The litigation instituted by the Lang Co. was because of assertion of such patent against Lang Co. It was settled with no judicial determination of the alleged invalidity of patent No. 2,372,912 which was the basis of the declaratory judgment action.

In the present suit, the charge of infringement against petitioner by respondent based upon such patent No. 2,372,912 required the expenditure of time and money by such petitioner to gather the evidence for invalidating such patent No. 2,372,912. Invalidity finding was avoided by dismissal by respondent as against the petitioner with prejudice, thereby freeing the petitioner so far as such patent is concerned, but still leaving it a threat against the public and against public interest.

WHEREFORE, it is respectfuly asked that the court in view of such inequitable conduct of the respondent grant the petition for Writ of Certiorari heretofore made, and which was denied by this court on March 12, 1956.

This petition is based upon substantial grounds available to petitioner although not previously presented, because of public interest requiring a settlement of whether or not an invalid patent may have its invalidity determination by a court evaded and averted by its owner for continuous maintenance of the threat of such patent over the public; and whether or not such procedure by the owner of a patent is of such deceit and inequity as to deprive the patent owner of standing in a court of equity in which such patent has been asserted against a defendant charged to infringe it.

Respectfully submitted,

SEARS, ROEBUCK AND COMPANY,
By FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

CERTIFICATE OF COUNSEL

I, Frank E. Liverance, Jr., counsel for the above named petitioner, Sears, Roebuck And Co., do hereby certify that the foregoing petition for rehearing of this cause is presented in good faith and not for purposes of delay; and further that the herein petition is restricted to the grounds of inequity and unclean hands of respondent specified.

FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.